

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
WACO DIVISION

THE TRUSTEES OF PURDUE) Docket No. WA 21-CA-727 ADA
UNIVERSITY)
)
vs.) Waco, Texas
)
STMICROELECTRONICS N.V.,)
STMICROELECTRONICS, INC.,)
STMICROELECTRONICS)
INTERNATIONAL N.V.) March 23, 2022

TRANSCRIPT OF DISCOVERY HEARING VIA VIDEOCONFERENCE
BEFORE THE HONORABLE ALAN D. ALBRIGHT

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15:29:47 1 THE COURT: Welcome. Suzanne, if you'd call the
15:29:49 2 case, please.

15:29:50 3 THE CLERK: Discovery hearing in Civil Action
15:29:52 4 W-21-CV-727, styled, The Trustees of Purdue University vs.
15:29:59 5 STMicroelectronics N.V. and others.

15:30:01 6 THE COURT: Announcements from counsel, please.

15:30:04 7 MR. SIEGMUND: Good afternoon, your Honor.

15:30:06 8 This is Mark Siegmund with Steckler, Wayne,
15:30:08 9 Cherry & Love for Purdue University. With me this
15:30:11 10 afternoon is Michael Shore and Raphael Chabaneix with
15:30:15 11 Shore Chan. And Mr. Shore will be the main speaker this
15:30:17 12 afternoon, your Honor.

15:30:22 13 MR. COHEN: Good afternoon, your Honor.

15:30:23 14 Justin Cohen of Holland & Knight representing
15:30:26 15 STMicroelectronics, Inc. And also with me is Max
15:30:28 16 Ciccarelli of the Ciccarelli law firm. And I'll be the
15:30:30 17 main speaker today.

15:30:31 18 THE COURT: Happy to take up your issues.

15:30:35 19 MR. SHORE: Your Honor, do you mind if I share my
15:30:38 20 screen with the Court?

15:30:39 21 THE COURT: Don't mind at all.

15:30:42 22 MR. SHORE: Hopefully this will work. Can you
15:30:51 23 see the chart on the screen, your Honor?

15:30:53 24 THE COURT: Yes, sir.

15:30:54 25 MR. SHORE: All right. So the Court's standing

1 orders don't really address the requirements for
2 disclosing an invalidity contentions a prior on-sale bar
3 defense. So we have a disagreement today over what is
4 required in an invalidity contentions to assert an
5 invalidity defense based upon an earlier sale for use in
6 the United States.

7 It's our position that for our client, Purdue, to
8 determine the strength, weakness, or even good-faith basis
9 for the assertion of a prior on-sale bar defense, a couple
10 of things are absolutely necessary. One, you have to
11 identify each individual product that you're claiming is
12 part of an on-sale bar defense. Not classes of products,
13 not families of products. Actual individual products.
14 You also have to provide exemplars of the products. So,
15 in other words, for us to test whether or not the products
16 infringe, we need to be able to take the products,
17 reverse-engineer them and determine whether they are
18 actually infringing products. Or would be infringing
19 products. Of course, they can't infringe if they predate
20 the patent. They're just products that would infringe if
21 they had come later.

22 The other thing you have to do to establish the
23 on-sale bar is, you have to establish a date a sale took
24 place. That should be disclosed. And because we might be
25 able to swear behind some of these sales, we don't know

1 the exact dates any of these sales took place, and you
2 have to disclose the customer in the United States to whom
3 you sold them and presumably delivered them in the United
4 States.

5 Now, for ST to -- in compliance with Rule 11, to
6 make an on-sale bar allegation, they have to have
7 investigated that a sale actually took place in the United
8 States of each part that they contend infringes. So they
9 would have to verify the sale, the date of the sale, and
10 obviously know who the customer is that they sold it to.
11 That should be extremely easy information for them to
12 provide if they actually did a Rule 11 investigation in
13 support of this defense.

14 These parts that they have identified
15 generically, they have provided some process flows, many
16 of which have to do with parts that have nothing to do
17 with silicon carbide. But they have provided some process
18 flows, but they provided the flows not for specific parts
19 that were sold in the United States but for families of
20 parts. So we don't know what the exact part numbers,
21 exact part types are. We don't know who the customers
22 are. We don't know who the date of sale are. We can't
23 match process flows to the individual parts so identified.

24 So what we've asked them for is simply to provide
25 for us as part of their invalidity contentions the bare

1 essential facts that would qualify these parts to be
2 infringing parts sold before the priority date. We did
3 not think this should be that hard.

4 So now, in their invalidity contentions, they
5 have identified ten families. When we went to investigate
6 -- you know, they asked us, well, you know, we're going to
7 produce these things in our offices. Come and see them in
8 our offices. We get to the office, they only have two
9 exemplars -- or from two families. Four exemplars from
10 two of the families. The actual part numbers for these
11 parts were not disclosed. Of course, they're capped in
12 plastic, so it does absolutely no good. I mean, it's like
13 holding up a piece of plastic and saying what's inside
14 this plastic infringes and was sold before the priority
15 date. We can't verify anything.

16 So all we're asking the Court to do is for them
17 to fill in this chart and replace all the words that say
18 none with actual information. We would like identified
19 product part numbers for each part they claim was sold in
20 advance of the priority date. We'd like to have the
21 process flows that they have produced tied to the specific
22 part that they are claiming is an invalidating part. We'd
23 like exemplars, four exemplars of each part that they're
24 going to claim is invalidating so we that could do our own
25 reverse-engineering to verify that the parts do or could

15:35:46 1 invalidate.

15:35:48 2 We'd like the evidence of the date of the
15:35:52 3 earliest U.S. sale so we could determine whether or not
15:35:54 4 they truly are prior art parts and whether or not there
15:35:57 5 was a sale in the United States, the identification of the
15:36:00 6 customer so, again, we can simply verify the basic facts
15:36:03 7 of the defense.

15:36:04 8 So to us, all of this information should be
15:36:08 9 readily available. It should have, in our opinion, been
15:36:12 10 produced as part of their invalidity contentions. They
15:36:15 11 didn't give us claim charts, you know, because if they had
15:36:19 12 given us claim charts with their own reverse-engineering
15:36:21 13 of all these parts and have these claim charts go through
15:36:26 14 the way we did it in our infringement contentions, but I
15:36:30 15 think that the best way for the Court to look at this is
15:36:33 16 imagine that we in our infringement contentions had done
15:36:37 17 what they did in these invalidity contentions. No claim
15:36:40 18 charts, no evidence, no backing, they would be here
15:36:44 19 screaming bloody murder that our infringement contentions
15:36:47 20 were insufficient. Their invalidity contentions for prior
15:36:52 21 on-sale bar parts should be just as comprehensive as the
15:36:57 22 plaintiff's invalidity contentions for infringing parts
15:36:59 23 because it's exactly the same information that each side
15:37:04 24 has to rely upon to conduct their investigation and to go
15:37:08 25 forward in the case.

1 And as far as the exemplar parts go, right now,
2 it is taking several weeks, if not months, to get time in
3 a lab to do reverse-engineering. So their idea that we
4 could just wait and potentially get exemplary parts later,
5 that's fallacious. That's wrong and I think they realize
6 that's wrong. And then, the other position they take is,
7 they don't want to give us exemplars because we might
8 break them. Of course we're going to break them. These
9 are not expensive parts. I don't think any of -- none of
10 them that we found cost more than \$12.

11 So this is not like where we're doing destructive
12 engineering, you know, of a CT scanner or destructive
13 engineering of a transmission, you know, on a tank or
14 something like that. These are -- these parts are made on
15 wafers on die where there's about 4 to 6,000 parts per
16 wafer. They have sold millions and millions of these
17 parts around the world, some for 20 years. Some of them
18 are still offered for sale, although we don't know if the
19 versions currently offered are the versions that were sold
20 before. But again, we're just asking for some very basic
21 information. We cannot evaluate their invalidity
22 contentions on prior on-sale bar without this information.

23 And again, if they did a Rule 11 investigation --
24 and I'm sure Holland & Knight did because they're, you
25 know, a big law firm -- they wouldn't assert a defense

1 like this without a Rule 11 investigation. So they have
2 to have this information at their fingertips, and there's
3 no reason why they can't produce it. And unless you have
4 any questions, your Honor, that's pretty much our
5 position. And I could unshare my screen if you don't need
6 it anymore.

7 THE COURT: A response.

8 MR. COHEN: Thank you, your Honor. And yes, Mr.
9 Shore, if you wouldn't mind unsharing your screen. Thank
10 you very much.

11 And, your Honor, I apologize. Christopher Ratway
12 is from our client, STMicroelectronics, Inc., is also on
13 today. I missed him at introductions.

14 THE COURT: Okay. I appreciate him taking the
15 time to be here.

16 MR. COHEN: Yes. So to put this simply, your
17 Honor, what Purdue is asking for is all of the evidence
18 that they would be pursuing during discovery that they
19 claim should have been provided with our invalidity
20 contentions. And that's just not the rule, that's not
21 what's required. Notice is what's required. Contrary to
22 what Mr. Shore said, we did provide claim charts. And to
23 date, Purdue hasn't complained about the sufficiency of
24 our claim charts or the sufficiency that we've provided
25 notice of our theories of invalidity for these prior art

1 parts.

2 And, your Honor, I'd just like to step back for a
3 minute to give some context. If you recall, the last time
4 we were before you, the Court had opened third-party
5 discovery. ST had served third-party discovery on what
6 Purdue claimed were closely related entities. And Purdue
7 refused and came to this court to basically quash any
8 attempts at early party discovery, and the Court agreed,
9 and no party discovery or closely related discovery has
10 taken place. Now, what Mr. Shore's complaining of is the
11 inability to test our invalidity contentions is literally
12 the exact same position that ST finds itself with respect
13 to Purdue's infringement contentions.

14 As a matter of fact, we've actually produced
15 evidence, process flows, claim charts, to support our
16 invalidity theories on the prior art products. Purdue has
17 not provided one piece of admissible evidence to support
18 its infringement contentions at this point and has
19 actually refused to provide any reverse-engineering that
20 would eventually be used to support its infringement
21 theories. So just like Purdue, we cannot test the
22 sufficiency of their infringement theories because that's
23 the purpose of discovery.

24 And a couple other minor points, your Honor. I
25 would say first is that there isn't a requirement to

15:41:05 1 provide and marshal all of your evidence at the contention
15:41:09 2 stage. The requirement is notice, which we provided with
15:41:12 3 claim charts with supporting design documents, process
15:41:15 4 flows, masks. That's what Mr. Shore was referencing that
15:41:18 5 he acknowledges was provided and produced.

15:41:21 6 Regarding reverse-engineering, destructive
15:41:27 7 testing, these aren't chips with unlimited supply, your
15:41:29 8 Honor. These are chips that were manufactured some 20
15:41:32 9 years ago. ST's supply is extremely limited, very
15:41:36 10 limited. And so, if we're providing chips for destructive
15:41:40 11 testing, we are going to quickly, you know, basically run
15:41:44 12 out of prior art chips and samples; and that's not only
15:41:48 13 for Purdue to use but for ST to use itself in presenting a
15:41:52 14 defense. And that prejudices ST not only in this case but
15:41:57 15 potentially future cases where this supply of chips won't
15:42:00 16 be available.

15:42:01 17 THE COURT: Can you give me an idea what number
15:42:05 18 you're talking about? Like for a specific chip that is
15:42:09 19 accused, you have one left, you have a dozen left, you
15:42:13 20 have a thousand left. I mean, I get that the problem.
15:42:18 21 These are chips that are -- I'm assuming, Mr. Cohen, are
15:42:21 22 no longer being manufactured so the supply is whatever the
15:42:25 23 supply is left.

15:42:26 24 MR. COHEN: Correct.

15:42:27 25 THE COURT: But can you give me an idea of the

15:42:29 1 number of chip -- what we're talking about here?

15:42:33 2 MR. COHEN: Yeah. Probably in like the 20 to 40
15:42:35 3 range. So.

15:42:39 4 THE COURT: I apologize. I interrupted you.

15:42:41 5 MR. COHEN: No, no, no, your Honor. Here to
15:42:43 6 answer your questions. And I don't have good firm
15:42:45 7 numbers. I know the supply is extremely limited for what
15:42:48 8 we do have.

15:42:49 9 THE COURT: Okay.

15:42:52 10 MR. COHEN: And, your Honor, the other point is,
15:42:53 11 what Mr. Shore's referencing is, of course, destructive
15:42:56 12 testing. And this court held in Anaya vs. Tricam that
15:43:00 13 there's a heightened standard that a party needs to make
15:43:02 14 to demand destructive testing. Purdue hasn't even tried
15:43:07 15 to make that. They haven't complained about the
15:43:09 16 sufficiency of understanding our theories. Everything Mr.
15:43:11 17 Shore went through is about testing the underlying
15:43:14 18 evidence, which is what party discovery is for, which will
15:43:17 19 open next month.

15:43:21 20 THE COURT: I think you're done, but if you're
15:43:22 21 not, let me know.

15:43:25 22 MR. COHEN: I am, your Honor. I'm here to answer
15:43:27 23 any questions you may have.

15:43:27 24 THE COURT: Mr. Shore.

15:43:28 25 MR. SHORE: First of all, the idea that they have

15:43:33 1 40 parts left is ridiculous. That is false. They may --
15:43:38 2 they also have wafers that have thousands of die that are
15:43:41 3 sitting on them, and they have to have those wafers still.
15:43:44 4 And if they want to produce a wafer, instead of a
15:43:48 5 cut-and-package part, that's fine, too. We'll take a
15:43:50 6 wafer. A wafer has about 4,000 die on it, but this is a
15:43:54 7 die-level case.

15:43:55 8 We've only asked for four exemplars of each part.
15:43:58 9 And when you are claiming a part is an invalidating part
15:44:02 10 and it cost \$4 retail, the idea that you can't provide the
15:44:07 11 other side four parts to allow them to test the
15:44:12 12 sufficiency of your contention is -- I don't even know how
15:44:17 13 to respond to that. But he can't tell you that they only
15:44:19 14 have 40 left. If he's saying they only have 40 left that
15:44:22 15 are packaged in like a T0220 or T0247 package, possible.
15:44:27 16 But they have wafers left and each of those wafers has 4
15:44:31 17 to 6,000 die on it. So we have to get back to reality.

15:44:38 18 And the second thing is, if you look at the --
15:44:40 19 when we share the screen, again, I want you to take a look
15:44:43 20 at what they've said because it's important. What they've
15:44:46 21 said here is that all products made with any of the MDxO
15:44:52 22 dies, including at least these two. So unless we have the
15:44:56 23 exemplars of what they're actually going to present as
15:44:58 24 invalidating, we don't even know if all products made by
15:45:02 25 anything related to that. That's what every single one of

15:45:07 1 these says, these are family of products. And they say
15:45:08 2 all products made with any of the MDxN dies, including at
15:45:14 3 least. So we don't even know if this is all of the parts
15:45:17 4 that they're going to claim are invalidating.

15:45:20 5 So what I -- to be fair, and what we're trying to
15:45:25 6 do here is be fair, make them tell us the exact parts.
15:45:28 7 Not families, not including but not limited to, not at
15:45:33 8 least. They need to tell us exactly what parts they're
15:45:35 9 going to claim are invalidating, give us four exemplars of
15:45:39 10 those parts, give us the process flow for those parts, and
15:45:43 11 as part of the contention, they have to tell us when they
15:45:47 12 were sold and who they were sold to, otherwise, they don't
15:45:51 13 even qualify as invalidating parts.

15:45:54 14 And all of this information had to be reviewed
15:45:59 15 and verified by the Holland & Knight lawyers or they
15:46:03 16 couldn't have made the allegation. But what we have
15:46:05 17 looking at that chart, your Honor, is we have 10 families,
15:46:09 18 and we don't even know which parts within the families
15:46:13 19 they're going to show up with at trial. We don't know
15:46:15 20 which parts of the families they're relying upon because
15:46:18 21 they keep saying including but not limited to or at least
15:46:21 22 the following.

15:46:22 23 So what we are trying to do is nail them down to
15:46:25 24 specific parts, give us exemplars and prove their -- and
15:46:30 25 not prove. Not marshal your proof. I don't need expert

15:46:34 1 declarations. I don't need expert depositions. I don't
15:46:37 2 need any of that. But what I do need for a prior art
15:46:40 3 product, I need the product and I need the basic proof
15:46:44 4 that it was prior. The customer and the date of the sale.
15:46:46 5 That's it. This should not be difficult.

15:46:53 6 THE COURT: Mr. Cohen.

15:46:55 7 MR. COHEN: Briefly, your Honor. Everything Mr.
15:46:57 8 Shore asked for are discovery requests. And all party
15:47:01 9 discovery is closed until it opens next month. Purdue has
15:47:04 10 taken the position in this court and others that ST is not
15:47:08 11 entitled to any early party discovery. And you've
15:47:11 12 noticed, your Honor, there aren't any discovery requests,
15:47:13 13 any Rule 34 requests, or samples. But Mr. Shore is asking
15:47:18 14 for discovery for strictly party discovery before it's
15:47:23 15 opened and demanding that that is what's required when ST
15:47:26 16 provides its invalidity contentions, and that's just not
15:47:28 17 the case.

15:47:28 18 And, your Honor, we believe this actually has
15:47:31 19 broader implications, not just for this case but for this
15:47:34 20 court. If defendants in order to provide sufficient
15:47:38 21 notice in their invalidity contentions of prior art
15:47:41 22 products and systems, then every defendant is going to be
15:47:45 23 required to basically marshal their evidence and provide
15:47:48 24 inspection and exemplars for any prior art device or
15:47:53 25 system at the preliminary invalidity contention stage,

1 before party discovery opens. And that, your Honor, on
2 the flip side, the plaintiffs are not required to provide
3 any evidence whatsoever. And Purdue in this case, has not
4 provided one shred of evidence that would allow ST to
5 evaluate their infringement contentions and their
6 infringement theories.

7 So we think fairness dictates that this wait
8 until party discovery, Purdue serves its document requests
9 and interrogatories, we will respond. We plan on
10 providing all of the evidence possible to support our
11 invalidity theories. And we've provided sufficient notice
12 thus far and will continue to do so when discovery opens.

13 MR. SHORE: Your Honor, 30 seconds.

14 THE COURT: Whatever time -- you're so engaging,
15 I would never put a time limit on you.

16 MR. SHORE: I'll try to stay brief.

17 First, what you just heard was not true. We
18 provided detailed claim charts with detailed reverse-
19 engineering, attached to our complaint. We didn't even
20 wait for infringement contentions. We literally provided
21 detailed reverse-engineering and claim charts attached to
22 the original complaint in our invalidity contentions. We
23 provided detailed claim charts with detailed
24 reverse-engineering.

25 So they have everything they need to determine

15:49:13 1 whether or not they infringe. And you know why we know
15:49:16 2 that? Because they claim that what they have was
15:49:19 3 sufficient to show their parts infringe. So again, I
15:49:23 4 didn't bring -- I'm not responding to his claims that we
15:49:26 5 haven't done what we're supposed to do. If they want to
15:49:28 6 bring that up at a separate hearing, I'm happy to do it.

15:49:31 7 But what we have here, if you look at our chart,
15:49:33 8 again, all we're asking them to do for -- is to tell us
15:49:38 9 specifically what parts invalidate. Not families, not
15:49:44 10 including but not limited to, not all products made by a
15:49:48 11 certain process. Give us exact parts. Give us exemplars.
15:49:54 12 Four. Not many. Four. And to tell us when the sale took
15:49:57 13 place and who the customer was so that we can just verify
15:50:01 14 that they are prior sold parts. That's not hard. It's at
15:50:06 15 their fingertips. They have to have it. If they don't
15:50:09 16 have it, they couldn't have made the allegation.

15:50:16 17 THE COURT: Anything else, Mr. Cohen?

15:50:18 18 MR. COHEN: Just briefly, your Honor. The
15:50:19 19 distinction between myself and Mr. Shore is that Mr. Shore
15:50:22 20 hasn't provided admissible evidence to support their
15:50:25 21 infringement contentions. They've selected pictures from
15:50:28 22 their reverse-engineering that they had conducted, but
15:50:31 23 thus far, have refused to provide any of that. It will
15:50:34 24 obviously be provided at some point during discovery or
15:50:35 25 what they select to use for their expert report. But we

15:50:38 1 have actually provided evidence in terms of process flows
15:50:42 2 and mask documents, design files.

15:50:44 3 On the other side, Purdue has provided pictures
15:50:48 4 of stuff that they may use later but not evidence, your
15:50:52 5 Honor, because that's for party discovery.

15:50:57 6 THE COURT: I'm not sure what your reluctance is
15:51:00 7 to -- and maybe I'm just not following -- your reluctance
15:51:06 8 is to being more specific, Mr. Shore said several times.
15:51:10 9 We are just asking them to identify the specific parts.
15:51:13 10 And I'm not sure what the reason is that could -- that
15:51:18 11 that couldn't be done now. Maybe I'm just missing it.

15:51:21 12 MR. COHEN: No, your Honor. This is the first
15:51:22 13 time we've heard that complaint that our contentions
15:51:25 14 weren't specific enough down to the specific parts. And
15:51:29 15 that's not in their dispute chart that they have even
15:51:32 16 asked for us to provide any additional identification or
15:51:34 17 be more specific on the part numbers. That's an issue
15:51:37 18 that we would have a problem addressing it being more
15:51:40 19 specific if that were the only complaint.

15:51:43 20 THE COURT: I think you said -- that's a problem
15:51:46 21 you wouldn't -- that's an issue you would not have a
15:51:48 22 problem addressing. Okay.

15:51:50 23 MR. COHEN: That's correct, your Honor.

15:51:52 24 THE COURT: Mr. Shore, anything else?

15:51:55 25 MR. SHORE: No, your Honor. I think one of the

15:51:57 1 things that we are kind of -- that is sort of the same is
15:52:02 2 in our infringement contentions that we have to provide a
15:52:08 3 priority date. They haven't provided us any date for when
15:52:11 4 they made a sale. All they say is before. We don't know
15:52:13 5 when. We don't know if we can swear behind it. We don't
15:52:17 6 know anything. But they have to know when the sale
15:52:19 7 occurred and what bought it. They have to know that.

15:52:24 8 THE COURT: Mr. Cohen, is there -- can you give
15:52:27 9 me an idea of the burden it would place on you to get more
15:52:31 10 specific dates?

15:52:33 11 MR. COHEN: At this time, I don't know
15:52:34 12 specifically, your Honor, about the burden that would
15:52:39 13 take. It's an investigation that was ongoing and will
15:52:41 14 continue to be ongoing. But I will note that your OGP has
15:52:48 15 a specific rule for plaintiffs to provide a priority date
15:52:52 16 disclosure and supporting evidence. On the other hand,
15:52:53 17 the invalidity contentions, there's not a requirement to
15:52:56 18 provide a specific date.

15:53:00 19 MR. SHORE: Your Honor, that's because for 102
15:53:01 20 and 103 art, the date is on publication. This isn't 102
15:53:05 21 or 103. And this is -- I will say this is a problem with
15:53:08 22 the OGP and that if you are going to have a prior sale,
15:53:13 23 the OGP does not expressly say you have to say what's the
15:53:16 24 date of the sale and who'd you sell it to. But that is
15:53:19 25 definitely a material part of any invalidity contention

1 that something was sold previously in the United States.
2 So that's basic and they have to know it or they could not
3 have made the allegation.

4 No defense lawyer could make that allegation
5 without verifying that a sale took place in the United
6 States. So he has to have that information at his
7 fingertips or he couldn't have made the allegation.

8 THE COURT: Mr. Cohen, that's what's concerning
9 me, too, is that it seems to me that -- because I know you
10 and your firm. I have great respect for you that it seems
11 to me, if you all were willing to put this information in
12 invalidity documents, contentions that you would have done
13 more than just figured it's gotta be before X date.
14 Again, I'm not sure -- in terms of burden, I'm not sure
15 under the rules -- we can go back and forth with who's
16 stumbling and all that -- whether or not it necessarily
17 has to be provided right now to Mr. Shore. I'll figure
18 that out in a second. But it does strike me that
19 something would -- that you had to have had that
20 information before you sent -- yes, sir.

21 MR. CICCARELLI: Your Honor, this is Max
22 Ciccarelli.

23 I want to speak to that, if I could, because I do
24 have some knowledge about some of these since I was
25 involved in the collection of some of this information.

1 The parts for which ST has prior exemplars, the limited
2 number that Mr. Cohen was referring to are actually parts
3 from a case that involved Mr. Shore and STMicroelectronics
4 back in the year 2000. And he might very well remember
5 these parts and these die names. So these were parts that
6 were actually sold right around the 2000 timeframe. The
7 problem is that the data, the information from that
8 timeframe that ST still has from that case shows that
9 there were sales prior to that time because the reports
10 were generated, but it doesn't have specific dates of
11 sale.

12 So Mr. Shore knows that they were right around
13 the year 2000. 1999, 2000. There were exemplars that
14 were produced to him and his firm as part of that
15 litigation. They conducted reverse-engineering as part of
16 that litigation because these were parts that he -- his
17 client had accused in that prior litigation. So they were
18 on sale around that time. We don't have access to the
19 data quite yet of exactly what days they were sold. We
20 will obviously work on collecting that and providing that
21 to them.

22 Some of these parts are parts where we provided
23 Mr. Shore with the design files and information as
24 potentially invalidating product because we believe based
25 on the discovery that we have done that they were sold

1 prior to that date. We have yet to be able to actually
2 track down actual sales. That is part of what discovery
3 is about. We will do that. Our goal here was, we're
4 going to put Mr. Shore on notice as early as humanly
5 possible about all the prior art products that we intend
6 to potentially rely on. Hence, these sort of generic
7 references. But we have given him the design files for
8 each of the dies so that he has in his possession mask
9 sets, process flows for each of these 10 different dies.

10 In terms of the name of products, the names that
11 we're aware of we provided to him and he even listed them
12 in his chart. So that's sort of where we are. We have
13 given everything that we have that allows them to evaluate
14 the defense. And during discovery, we will scour the
15 Earth, as your Honor probably imagines, for evidence of
16 the earliest possible sale. I hope that helps.

17 THE COURT: Mr. Shore.

18 MR. SHORE: That's interesting because the parts
19 that were involved 22 years ago did not contain any
20 silicon carbide. None. They can't be -- they can't be
21 invalidating prior art parts because these are silicon
22 carbide patents and silicon carbide MOSFET. So again,
23 that's the first I've heard this. But what I just heard,
24 I believe, is they cannot put forward evidence today of
25 any specific sales in the United States of these parts

15:57:48 1 that they claim are invalidating parts. That's a
15:57:50 2 violation of Rule 11.

15:57:52 3 So then, the other thing is, he does not explain
15:57:56 4 why they say all products made with, all products made
15:58:00 5 with. We're entitled to specific parts, specific part
15:58:04 6 numbers. They would not be able to walk into court and
15:58:08 7 say all products made with. So again, our request is
15:58:12 8 very, very simple. Give us the part numbers of the
15:58:15 9 products you claim are invalidating, give us the process
15:58:18 10 flows for each of those parts, give us four exemplars, and
15:58:23 11 give us the date of the first sale that you're going to
15:58:24 12 claim is an on-sale bar and the customer. Very simple.
15:58:28 13 Very straightforward.

15:58:30 14 And I would think that maybe the Court might even
15:58:32 15 consider putting that in its OGP going forward so you
15:58:35 16 never have to deal with this issue again. But if you're
15:58:37 17 going to claim a part is an on-sale bar part, you need to
15:58:41 18 be prepared to identify the part, identify the process
15:58:44 19 flow, identify the date of sale, identify the customer.
15:58:48 20 And that is basic. It's very basic.

15:58:57 21 THE COURT: Anything else?

15:59:00 22 MR. COHEN: Briefly if I could, your Honor.
15:59:02 23 Today's the first time that Purdue's complained about sort
15:59:05 24 of the lack of disclosure to being specific to part
15:59:08 25 numbers and specific dates. In the dispute chart, what

15:59:13 1 they requested were exemplars, all engineering and design
15:59:16 2 files, all evidence of use and pre-use predating sales.
15:59:22 3 And without that supporting evidence, what they asked this
15:59:25 4 court to do is to strike our prior art products from the
15:59:27 5 invalidity contentions.

15:59:29 6 So before today, that was the dispute coming to
15:59:32 7 your Honor. Had the dispute been we would like more
15:59:34 8 clarification on the part numbers or on a specific date, I
15:59:37 9 believe that's something the parties could have worked
15:59:40 10 out. And one minor comment, your Honor, because I feel
15:59:43 11 compelled to address this.

15:59:45 12 Mr. Shore mentioned Rule 11. In nearly every one
15:59:50 13 of my encounters so far in this case, we've received
15:59:53 14 accusations of failing to comply with the Court's orders,
15:59:55 15 the federal rules, Rule 11. None of these accusations
15:59:58 16 have any basis in fact or law. And, quite frankly, I
16:00:03 17 don't think it's appropriate to be hurling those types of
16:00:06 18 accusations back and forth, but I do feel the need to
16:00:09 19 address it.

16:00:11 20 THE COURT: Okay. I'll be back in a few seconds.

16:14:56 21 If we could go back on the record, please. The
16:14:59 22 Court is going to deny the relief plaintiffs are seeking.

16:15:05 23 And so, is there anything else that we need to
16:15:07 24 take up? Mr. Shore?

16:15:11 25 MR. SHORE: No, your Honor.

16:15:13 1 THE COURT: Mr. Cohen?

16:15:15 2 MR. COHEN: Nothing from the defendant, your

16:15:17 3 Honor. Thank you very much.

16:15:18 4 THE COURT: Wish you guys a good afternoon. Take

16:15:21 5 care.

6 (End of proceedings.)

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UNITED STATES DISTRICT COURT)
WESTERN DISTRICT OF TEXAS)

I, LILY I. REZNIK, Certified Realtime Reporter,
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